

**STATEMENT OF SUBSTANCE OF INTERVIEW**

An interview was conducted between Examiners Paul Nguyen-Ba, William Bashore and the undersigned Applicant's representative on June 16, 2004. Claim 1 was discussed: in particular, the rejection of claim 1 in view of McGraw. Applicant's representatives argued that the McGraw reference does not disclose all the limitations of claim 1. No agreement was reached.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

**REMARKS**

***Introduction***

This Amendment, submitted in response to the Office Action dated March 17, 2004, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

***Preliminary Matters***

Applicant respectfully requests that the Examiner accept the drawings filed June 28, 2002 and acknowledge the same in the next Office paper.

As a further preliminary matter, Applicant respectfully requests that the Examiner initial the PTO/SB/08 A & B (modified) form filed April 13, 2004 and return a copy of the initialed form to the applicant.

*Claim Rejections*

Claims 1-45 are all the claims pending in the application. Claims 1-9, 11-24, 26-39 and 41-45 have been rejected under 35 U.S.C. § 102(b) as being anticipated by McGraw-Hill Primis Custom Publishing ([www.mhhe.com/primis](http://www.mhhe.com/primis)), allegedly archived circa 1998, via the Wayback Machine ([www.archive.org](http://www.archive.org)) (hereinafter McGraw). Claims 10, 25, and 40 have been rejected under 35 U.S.C. § 103(c) as being unpatentable over McGraw.

Applicant respectfully submits the following in traversal of the rejections, assuming, only for the purposes of argument, that the McGraw reference qualifies as prior art under § 102.

*Rejection of claims 1-9, 11-24, 26-39 and 41-45 under § 102(b) as  
being anticipated by McGraw*

The Examiner asserts that McGraw teaches “a method for adding content to a first hierarchically structured content object stored as a first plurality of content entities in a data repository, the data repository containing a second plurality of content entities of a second hierarchically structured content object, each of the content entities having an identifier, comprising defining the first object by a first outline of containers and content entity identifiers, such that **adding the content entity identifier of one of the second plurality of content entities to the first outline adds the identified content entity to the first object**” as recited in claim 6.

The Examiner states that a customized textbook as described in McGraw is “structured into a hierarchy such that each content entity ranks or grades with each level subordinate to the one above,” and therefore, a first hierarchically structured content object, as recited in claim 6

allegedly, is disclosed. In particular, the Examiner asserts that McGraw, in showing a table of contents (e.g. headings: a preface, Introduction to Law, Chapter 1, Courts and Litigation, Chapter 2) for an on-line text book, *Corley, et al.: The Legal and Regulatory Environment of Business, 11<sup>th</sup> Edition*, as indicated on page 7 of McGraw, teaches a first hierarchically structured content object.

The Examiner then asserts that content entities of the first content object (i.e., the Corley textbook) are displayed on the “Review” and “Cover” links of the custom publishing process steps, such as discipline, volume and chapter, etc. However, the McGraw reference provided by the Examiner does not appear to show or describe what happens when either the “Review” or “Cover” links are selected. In particular, there is no indication, in any of the McGraw materials provided by the Examiner, that selecting either the “Review” or “Cover” link results in a display of *Corley, et al.: The Legal and Regulatory Environment of Business, 11<sup>th</sup> Edition* (first content object as cited by the Examiner) or any of the other books illustrated in McGraw.

The Examiner then asserts that the Primis database disclosed in the McGraw reference teaches a data repository containing a second plurality of content entities (discipline, volume, chapter, section, etc.) of a second hierarchically structured content object (college-level material including the textbooks, supplements, journals and magazines on the Primis database). In the Office Action the Examiner asserts that the URLs for each of the content entities (discipline, volume, chapter, section, etc. of the college-level material including the textbooks, supplements, journals and magazines on the Primis database) are identifiers for those content entities.

The Examiner further asserts that McGraw teaches defining the first object (i.e., *Corley, et al.: The Legal and Regulatory Environment of Business, 11<sup>th</sup> Edition*) by a first list of content entity identifiers (URLs and Item Identifier numbers) organized as an outline of containers. The Examiner contends that when a URL for a content entity (i.e., an “Add” button shown next to a chapter of Corley, et al. on page 7 and similarly on pages 9 and 12) is selected, the content entity identifier of one of the second plurality of content entities (e.g., a discipline, volume, chapter, section etc. of another text held in the Primis database) is added to the first list of content entity identifiers (i.e. the parts of the of *Corley, et al. textbook*). It is respectfully submitted that the McGraw reference does not disclose or suggest operating in that manner.

The portion of McGraw cited by the Examiner for teaching the claimed first object is *Corley, et al.: The Legal and Regulatory Environment of Business, 11<sup>th</sup> Edition*, shown on page 7 of McGraw. McGraw neither teaches nor suggests that selecting an “Add” hyperlink for a portion of Corley et al. results in the addition of content held in the Primis database (one of the second plurality of content entities) to Corley et al. (the first object). Rather, the McGraw reference does not disclose what occurs when the “Add” hyperlink is selected. It is believed that selecting the “Add” hyperlink, results in the addition of the corresponding material to a customized book which is being created by a user. For example, on page 7 of McGraw, selecting the “Add” hyperlink next to “1pg New! What is Law?” located below “Introduction to the Law,” results in the addition of the chapter “What is the Law?” to a book being created by a user. However, it is respectfully submitted that McGraw either teaches or suggests adding a content

entity identifier of one of a second plurality of content entities to a first outline that defines a first object, as required by claim 6.

For the above reasons, it is respectfully submitted that claim 6 and its dependent claims should be deemed patentable. Since claims 1, 16, 21, 31 and 36 recite similar elements, claims 6, 16, 21, 31 and 36 and their dependent claims are also not rendered unpatentable.

***Rejection of claims 10, 25, and 40 under § 103(c) as being unpatentable over McGraw***

Claims 10, 25, and 40 should be deemed patentable by virtue of their dependency to claims 6, 21, and 36 for the reasons set forth above.

***New claims***

Applicant has added claims 46-51. These new claims are supported at least in Figs. 20A-20C and 22E. Claims 46-51 are patentable at least by virtue of their dependency to patentable claims for the reasons set forth above.

***Submission of Appendix on CD-R***

Submitted herewith for filing in the present application is a Compact Disc-Recordable (CD-R) having recorded thereon an ASCII text computer program listing prepared in compliance with 37 C.F.R. §1.96, and a duplicate copy of the CD-R. The computer program listing was created and stored on the CD-R in IBM-PC format using a Microsoft Windows operating system. Each CD-R is physically labeled with the title of the invention, the docket/application numbers of the application, the creation date of the CD-R and an indication of the inventorship. Two copies of the CD-R are provided (numbered CD #1 of 1 / Copy 1 and CD #1 of 1 / Copy 2, respectively), with each copy containing the file detailed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO.: 09/489,576

ATTORNEY DOCKET NO. A8525

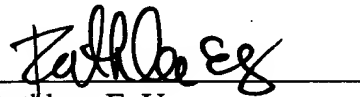
File Contents of CD #1 of 1:

File Name	Files Size	Creation Date
AppendixA.txt	107 KB	5/16/2002

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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